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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/229,704	01/13/1999	FRANCIS R. WALDMAN	1298/OE751	5569

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EXAMINER

TRAN, THIEN D

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/229,704

Applicant(s)

WALDMAN, FRANCIS R.

Examiner

Thien D Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-8 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. In the view of Applicant's argument presented in the appeal brief, the finality of the rejection of the last office action is hereby withdrawn by the Examiner. A new office action follows as below:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 9-14, 17 are rejected under 35 U.S.C. 103(a) as being participated by Kalmanek, Jr. et al (U.S Patent No 6,483,912 B1).

Regarding claims 1, 9, 17, Kalmanek discloses a method for interconnecting a calling party access network having a calling telephone 190 and communication device 180 (party host) and a called party access network having a called telephone 191 and communication device 181 (party host) an intermediate switching asynchronous transfer mode network and network edge devices 120 and 121 (border nodes) associated with each asynchronous transfer mode system comprising (figure.1, col.5 lines 1-55):

routing a call from said calling party host to the called party host over the intermediate switching asynchronous transfer mode network based on intermediate switching ATM network addressing scheme that is recognized by border node and independent of an addressing scheme of the asynchronous transfer mode systems (figure.2, col.17 line 40 to col.18 lines 50).

Kalmanek does not disclose that the access network is the asynchronous transfer mode network (ATM system), which is a well-known network's type using higher bandwidth. Therefore, it would have been obvious to one having ordinary skill in the art to replace kalmanek's access network with ATM network so that the transmission speed in the access network achieves a higher rate.

Regarding claim 2, Kalmanek discloses a method comprising:

substituting at the border node of the calling party asynchronous transfer mode system in a called party address information element an intermediate switching asynchronous transfer mode network address of the border node of the called party asynchronous transfer mode system for the asynchronous transfer mode system address of the called party host (col.17 lines 40- 65); and

routing the call over the intermediate switching asynchronous transfer mode network from border node of the calling party asynchronous transfer mode system to border node of the called party asynchronous transfer mode system based on the intermediate switching asynchronous transfer mode network address in the called party address information element (figure.1).

Regarding claim 10, Kalmanek discloses that switch border nodes are asynchronous transfer mode switches (figure.2).

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Regarding claims 11, 13, Kalmanek discloses that calling party asynchronous transfer mode system comprises a calling party host directly connected to calling party border node (col.12 lines 5-30).

Regarding claims 12, 14, Kalmanek discloses a calling party asynchronous transfer mode system comprises:

a calling party host; and

at least one calling party non-border node connected between said calling party host and said calling party border node (col.13 lines 25-45).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claims 15, 16 are rejected under 35 U.S.C. 102(e) as being participated by Kalmanek, Jr. et al (U.S Patent No 6,483,912 B1).

Regarding claims 15, 16 Kalmanek discloses an asynchronous transfer mode switching method comprising:

substituting at the border node of the calling party asynchronous transfer mode system in a called party address information element an intermediate switching asynchronous transfer mode network address of the border node of the called party asynchronous transfer mode system for the asynchronous transfer mode system address of the called party host (col.17 lines 40- 65);

Allowable Subject Matter

6. Claims 3-8 are allowed.

Conclusion

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thien Tran whose telephone number is (703) 308-4388. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (703) 308-6602. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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ALPUS H. HSU
PRIMARY EXAMINER

Thien Tran